



# UNITED STATES PATENT AND TRADEMARK OFFICE

*cl*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/731,702

12/09/2003

Stephen L. Buchwald

MTV-014.05

3262

25181

7590

05/31/2006

FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
155 SEAPORT BLVD  
BOSTON, MA 02110

EXAMINER

SACKEY, EBENEZER O

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/731,702

Applicant(s)

BUCHWALD ET AL.

Examiner

EBENEZER SACKY

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 19-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,13,14,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 7,12,15 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/17/04, 3/19/04, 9/23/04, 11/15/04</u>                                   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Status of Claims**

Claims 1-106 are pending.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Information Disclosure Statement***

Receipt of the Information Disclosure Statement filed 03/17/04, 03/19/04, 09/23/04, 10/07/04 and 11/15/04 respectively is acknowledged and has been entered into the file.

Signed copies of the 1449 are attached herewith.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18 are, drawn to ligands (I) and (II), classified in class 558, subclass 70+.
- II. Claims 19-21 are, drawn to methods represented by scheme I, classified in class 564, subclass 106+.
- III. Claims 22-38 are, drawn to methods represented by scheme 2, classified in class 548, 564, in various subclasses.
- IV. Claims 39-41 are, drawn to methods represented by scheme 3, classified in class 548, 549, 560, in various subclasses.
- V. Claims 42-51 are, drawn to method represented by scheme 4, classified in class 548, 549, in various subclasses.
- VI. Claims 52-61 are, drawn to methods represented by scheme 5, classified in class 560, subclass 8+.
- VII. Claims 62-96 are, drawn to methods represented by schemes 6 and 7, classified in class 564, subclass 106+.
- VIII. Claims 97-106 are, drawn to methods represented by scheme 8, classified in class 548, 549, 560 in various subclasses.

Art Unit: 1626

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method as claimed can be used to make other and materially different products such as shown in U.S. Patent 5,362,899.

Groups II-VIII are drawn to seven distinct processes for producing compounds of structural formulae 6, 7, 5, 5', 4, Ia, Ib as demonstrated by the different reactive steps, reactants and conditions. Each Group of invention is capable of supporting its own patent and thus, distinct. The Examiner is required to conduct a commercial data base search in addition to the class and subclass search on each of the groups which is quite burdensome.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Dana Gordon on 05/08/06 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-106 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Substituent R<sub>3</sub> has not been defined in the claims thus, rendering the claims indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomori et al., An Improved Synthesis of Functionalized Biphenyl-Based Phosphine Ligands, Journal of Organic Chemistry 65(17), 2000, 5334-5341.

Art Unit: 1626

Applicants claim a ligand represented by structure I, where the substituents are as defined in claim 1.

Tomori et al., discloses compounds, which anticipated the instant compounds where R is *t-butyl* and each of R<sup>1</sup> and R<sup>2</sup> are absent. See second compound on the abstract provided.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 3-6,8-11, 13-14 and 16-17 are rejected under 35 U.S.C. 102(a) as being anticipated by Huang et al., Expanding Pd-Catalyzed C-N Bond-Forming Processes: The First Amidation of Aryl Sulfonates, Aqueous Amination, and Complementarity with Cu-Catalyzed Reactions, Journal of the American Chemical Society 125(22), 6653-665 (2003).

Applicants claim a ligand represented by structure I, where the substituents are as defined in claim 3.

Huang et al., discloses phosphine compounds which anticipate instant ligand when each of R' is alkyl, R is alkyl and R<sub>1</sub> and R<sub>2</sub> are absent. See second and third compound of page 2 of the abstract provided.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 are rejected under 35 U.S.C. 102(a) as being anticipated by Old et al., Efficient Palladium-Catalyzed N- Arylation of Indoles, , Organic Letters 2(10) 1403-1406 2000,

Applicants claim compounds of Ligands formula (I), where the substituents are as defined in the claim 1.

Old et al., disclose Ligands which anticipate instant claims 1 and 2 when  $(R)_2$  is  $(Bu-t)_2$  and  $R_2$  alkyl and  $R_1$  is not present. See the abstract provided.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Aranyos et al., Novel Electron-Rich Bulky Phosphine Ligands Facilitate the Palladium-Catalyzed Preparation of Diaryl Ethers. See compound number 3, on page 4370, compounds 5 and 6 on page 4372.

***Allowable Subject Matter***

Claims 7, 12, 15 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

---

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

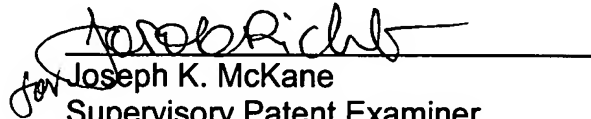


Art Unit: 1626

supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS  
May 25, 2006

  
for Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1